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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,634	03/09/2001	Shimon Shmueli	4989-005	8535
27820 7590 03/08/2007 WITHROW & TERRANOVA, P.L.L.C. 100 REGENCY FOREST DRIVE SUITE 160 CARY, NC 27518			EXAMINER FADOK, MARK A	
			ART UNIT 3625	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/802,634

Applicant(s)

SHMUELI ET AL.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of reply to office action mailed 10/19/2006, which was received 12/15/2006. Acknowledgement is made to the amendment to claim 21 and the cancellation of claims 8 and 28. The applicant's response has been carefully considered, but was not found to be persuasive, therefore the previous office action will be restated below:

### ***Examiner's Note***

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3,6,7,9-15,18,19,21-23,26 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of Arnold (US 6,950,857), in view of TURGEON (US 2003/0014371) and further in view of Official Notice.**

**In regards to claim 1,** Pitroda discloses a portable device comprising:

a body (FIG 1);

memory within the body containing software and financial account information (FIG 3);

an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 30, col 10, lines 40-45);

the software adapted to execute on the host computing device to instruct the host computing device (col 10, lines 40-50 and FIG 4) to:

Pitroda teaches the use of stored financial information on a UET to conduct a transaction over the internet (FIG 2) and also teaches programming the portable device for special application. Pitroda does not however specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using an ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality

within the UET for the obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

automatically execute on the host computing device in association with the computing session (FIG 4, initialization and I/O drivers, item 419 & 422). Applicant may argue, however, that Pitroda does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an auto-execute program because this will simplify the accessing of the remote application by not requiring the devices application to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device. and

Pitroda teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. TURGEON teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Pitroda erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure.

**In regards to claim 2**, Pitroda teaches wherein the financial account information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of financial accounts (FIG 4);

receive selected indicia from the user (FIG 13); and

fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (FIG 16).

**In regards to claim 3**, Pitroda teaches wherein the software is further adapted to provide an authentication routine to execute on the host computing device,

the authentication routine instructing the host computing device to receive authentication indicia from a user via an interface on the host computing device (FIG 11) and

determine if the authentication indicia received from the user matches authentication indicia stored on the portable device (col 14, lines 7-18).

**In regards to claims 6 and 7**, Petridis teach the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-

functional descriptive material (see MPEP 2106(b)) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

**In regards to claim 9**, Pitroda teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 4).

**In regards to claim 10**, Pitroda teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 4).

**In regards to claim 11**, Pitroda teaches wherein the interface is adapted to directly interface a port in the host computing device (UET and CIU).

**In regards to claim 12**, Pitroda teaches wherein the interface is adapted to provide a wireless interface with the host computing device (col 10, lines 4-25).

**Claims 4,5,16,17,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda (US 5,884,271) in view of TERGEON (US 20020029254) in view of Inala (US 6,199,077) and further in view of Official Notice.**

**In regards to claim 4**, Pitroda teaches storing applications on a portable device that can be activated on a PC, but does not specifically mention that the application is one that activates an auto login to a second web page. Inala teaches an auto login feature (FIG 5). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Pitroda an application for auto logging because this would save the user time and provide a automatic and transparent access to restricted websites to the user.

**In regards to claim 5**, the combination of Pitroda/Inala teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (Inala, col 8, lines 15-30).

**In regards to claims 13-19 and 21-27**, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

### **Second 103 Rejection**

**The examiner in an effort to map for the applicant all the best art cited is also providing the following rejection in view of Davis.**



**Claims 1-7,9-19 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 20020029254) in view of Arnold, in view of TERGEON and further in view of Official Notice.**

**In regards to claim 1, Davis discloses a portable device comprising:**  
**a body (FIG 4, item 410);**  
**memory within the body containing software and financial account information (para 0036);**  
**an interface associated with the memory and adapted to facilitate interaction with a host computing device during a computing session (FIG 7);**  
**the software adapted to execute on the host computing device to instruct the host computing device (para 0036) to:**

Davis teaches the use of wallet applications on a smart card with server like functionality to conduct transactions over the internet (FIG 5) and also teaches processing applications from the smart card on a client device (para 0043) along with functionality to populate a vendor site with credit card information (para 0059). Davis does not however, specifically mention that the financial fields of a web page are recognized and financial fields are filled in during the web based transaction. Arnold teaches using a ancillary computing device to analyze web page fields and fill in the appropriate fields. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include auto fill functionality in Davis's smart card for the

obvious reason that auto form filling saves time and is more accurate than manual filling of forms.

Davis teaches the use of multiple user applications (para 0031) but does not specifically mention auto execution on the PC. As stated in applicant's specification (page 6, line 30 – page 7, line 15) auto run capability is old and well known in the art, the examiner additionally takes official notice that automatically executing a remote device on a host device is old and well known in the art. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an auto-execute application on the server like s\mart card of Davis, because this will simplify the accessing of the remote application by not requiring the device to be manually loaded when it is clear that the user wishes to use the device when it is inserted into the host device. and

Davis teaches secure transactions over the internet via a PC, but does not specifically mention that residual data is flushed from the client PC. TUGREON teaches flushing the PC memory to remove data after use in a transaction (FIG 5, item 521). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Davis erasing the memory in the client PC, because this will improve the security of sensitive data by not allowing the data to reside on a device that is not secure or will be usable by another at a latter time.

**In regards to claim 2,** Davis teaches wherein the financial account

information relates to a plurality of financial accounts, the software further adapted to instruct the host computing device to:

- query a user to select one of the plurality of financial accounts (FIG 8C);
- receive selected indicia from the user (FIG 8C); and
- fill in the financial account fields in the web page with certain of the financial account information corresponding to the selected one of the plurality of financial accounts (see response to claim 1).

**In regards to claim 3**, Davis teaches server like functionality on a smart card, the use of passwords to access applications and the further use of a password to access critical data (FIG 8B), but does not specifically mention that the access to the smart card is controlled by an authentication routine. The examiner takes official notice that the use of authentication routines to access secure information was old and well known in the art at the time of the instant invention. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis an authentication routine, because this would assure that only users authorized access to the secure information are permitted to access and use the secure information from the smart card.

**In regards to claim 4**, Davis teaches wherein the portable device stores login information for a second web page associated with the web-based transaction and the software is further adapted to instruct the host computing device to determine if login

information is necessary for the second web page and provide the login information upon entering the second web page (para 0060).

**In regards to claim 5**, Davis teaches wherein a bookmark for the web page is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing to make the bookmark accessible by the browser running on the host computing device such that a user may use the bookmark to efficiently access the web page via the browser (FIG 8B).

**In regards to claim 6**, Davis teaches within the portable device stores shipping information for a item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web page to facilitate delivery of the item selected for purchase (FIG 8A).

**In regards to claim 7**, Davis teaches wherein the shipping information includes a plurality of shipping addresses, the software further adapted to instruct the host computing device to:

query a user to select one of the plurality of shipping addresses ;

receive selection indicia from the user (FIG 8D); and

fill in the shipping address fields with certain of the shipping information

corresponding to the selected one of the plurality of shipping addresses See response to claim 1).

Further, in regards to claims 6 and 7, Davis teaches the data filling objects in regards to financial data (see claims 1 and 2 above), but does not specifically mention that the data being processed is shipping information. Since the limitation of shipping information does not impart any functionality this limitation is considered to be non-functional descriptive material (see MPEP 2106(b) and is therefore not considered to provide patentable distinction. The examiner contends that the system would work equally well with the auto filling of any type of data.

**In regards to claim 9**, Davis teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device (FIG 8A).

**In regards to claim 10**, Davis teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 8A).

**In regards to claim 11**, Davis teaches accessing a client device using a smart card accepting device (para 0031).

**In regards to claim 12**, Davis teaches accessing a client device, but does not specifically mention that the client is accessed wirelessly. The examiner takes Official Notice that it was old and well known in the art at the time of the invention to use wireless technology to access client devices. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Davis, wireless technology, because this would offer another means of accessing a client device that might only have wireless access capability, thus incorporating this technology in the smart card would increase the usefulness of the Davis system and increase sales.

**In regards to claims 13-19 and 21-27**, these claims are considered to be parallel claims to claims 1-8 and are rejected for the same rationale.

As an initial matter, the examiner agrees with applicant's assessment of the references in the first rejection as is presented on page 8 last paragraph of the reply.

### ***Response to Arguments***

Applicant's arguments filed 12/15/2006 have been fully considered but they are not persuasive.

### **Pitroda Rejection**

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection

does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant argues that Pitrada does not teach the examiner disagrees and further directs the applicant's attention to col 11, lines 58-67, and the discussion of software being stored for use on the UET.

Applicant argues that the UET does not instruct the host computer to do anything the examiner disagrees and directs the applicant's attention to (col 12, lines 33-36), where it is clear that the UET carries many software programs that interact with the host PC to display information in a particular format.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The applicant appears to argue that the software that provides functionality resides exclusively on the portable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to this argument, the "software instruct the host computing device" merely implies that a signal is provided from the device to execute software that is present on the host. This is evident in the auto execute feature of the instant invention where plug and play technology is used. As is well known in the art, the plug and play software is resident on the host and auto execute merely by recognizing the device or an indication of the type of information that is present on the portable device.

Applicant argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the software that is resident on the portable device that places the information that is retrieved by the robot into the form on the laptop. Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appears to be arguing the factual nature of



the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided.

Applicant's argues that the combination of Pitroda with an auto run capability would unsatisfactory for its intended purpose. The examiner disagrees and notes that the UET must interact with the host and different drivers need to executed on the host, therefore, auto execute would be desirable to automatically execute this software and quickly provide a session to the user.

Applicant argues that the code for erasing the records is not on the portable device. The examiner agrees that the code is apparently not from the portable device of TURGEON., however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of TURGEON. Further, TURGEON discloses the use of PC memory flush function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Applicant argues that the combination of Pitroda and TURGEON does not teach "in association with the termination of the computing session" the records are removed. The examiner disagrees and directs applicant's attention to item 514, which ends the interactive session with the portable device and initiates the request for the e-pin and transfer to the web server. Once the consumer enters the e-pin the data is automatically

erased from the memory. Therefore the termination of the interactive session between the host and the portable device is clearly associated with the flushing of the memory.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge of one of ordinary skill in the art is applied. Applicant appears to asking for a reference that supports the motivation. For this purpose Nobakht (US PG PUB 20040205155) is provided. The applicant is directed to paragraphs 0009 and 0064 for support of the security related erasure.

Applicant argues that Pitroda does not need additional security since the UET includes security features. The examiner disagrees and notes that in order for the PC to process the data the information has to stored at least in temporary memory for the processor to process the data, therefore private information is transferred so additional erasure for security purposes would be needed to assure that secure data is not compromised.

Applicant argues that the data would be needed for a period of time to do the analysis. The examiner notes that this is but one embodiment and does not represent all the situations such as POS terminal or ATMs for example. Regardless, the use of the

computation functions does not present a length of time associated with the transactions and as stated in TURGEON, "First and foremost is the issue of security. Fraud in transactions may cost Web merchants many thousands of dollars in lost revenues. Furthermore, to do on-line purchases without any reservations, customers need to feel safe and assured that their confidential information will not be intercepted and misused by fraudulent users or by an unscrupulous merchant" Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues the motivation provided in the previous office action regarding Inala. The examiner further directs applicant's attention to col 1, lines 45-60 of Inala for the following motivation explaining the problem to be solved "One problem that is encountered by an individual who has several or many such subscriptions to Internet-brokered services is that there are invariably many passwords and/or log-in codes to be used. Often a same password or code cannot be used for every service, as the password or code may already be taken by another user. A user may not wish to supply a code unique to the user such as perhaps a social security number because of security issues, including quality of security that may vary from service to service. Additionally, many users at their own volition may choose different passwords for different sites so as to have increased security, which in fact also increases the number of passwords a user may have".

Applicant argues that the combination of Pitroda/Arnold/TURGEON/Official Notice and Inala does not teach wherein the portable device stores login information for a web site associated with the web passed transaction. The examiner disagrees and further directs the applicant's attention to Inala col 6, line 64 – col 7, line 10.

Applicant argues that the code for auto-login is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of auto-login function software except for the software being on the UET. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Applicant argues that the combination of Pitroda and Inala does not teach the use of Bookmarks. The examiner disagrees and refers the applicant to the col 8,, lines 25-41 of Inala, which was referenced in the last office action.

Applicant argues that the code for establishing bookmarks is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Pitroda's UET is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of a book mark function software except for the software being on the UET. However, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to place this software on the UET, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

### ***Response to Davis Rejection***

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., The applicant appears to argue that the software that provides functionality resides exclusively on the portable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In regards to this argument, the "software instruct the host computing device" merely implies that a signal is provided from the device to execute software that is present on the host. This is evident in the auto execute feature of the instant invention where plug and play technology is used. As is well known in the art, the plug and play software is resident on the host and auto execute merely by recognizing the device or an indication of the type of information that is present on the portable device.

Applicant argues that the applications on the smart card act locally and do not execute on the host to instruct the host to perform the steps of the instant claims. The examiner disagrees and notes that it is inherent that a application that is operated on a secondary device such as when a smart card executes on a PC, must use the PC to execute the application in order to have the PC function.

Applicant argues that Arnold teaches a Robot that is not present on the portable device and therefore teaches away from instant invention. The examiner disagrees and notes that this is not the part of the teaching in Arnold that is relevant. The relevant part is the software that is resident on the portable device that places the information that is retrieved by the robot into the form on the laptop. Davis' smart card is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Arnold. Further, Arnold discloses the use of a form filling software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Applicant argues the motivation for combining auto run capability. To provided evidence of this motivation that it is an efficient manner of starting a program, DiGiorgio is introduced and applicant is directed to col 2, lines 24-34, where it is stated that "The secure token device may hold identification information that is globally unique across geographic and political boundaries. This identification information is held securely on the secure token device. It is difficult for a party to physically access the identification information. The secure token device serves as a physical token of authenticity for the party. In order to fraudulently use the secure token device, a party must both physically take the secure token device and also be aware of the PIN associated with the user of

the secure token device. Hence, the use of the secure token device helps to decrease the probability of fraud.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has used knowledge that was generally available in the art to show motivation for including auto run capability, however, since applicant appears to be arguing the factual nature of the motivation the examiner provides US 5,633,843 to Gupta et al see col 4, 20-30 as support for the motivation provided.

Applicant's argues that the combination of Davis with an auto run capability would unsatisfactory for its intended purpose. The examiner disagrees and notes that the smart card must interact with the host and different drivers need to executed on the host, therefore, auto execute would be desirable to automatically execute this software and quickly provide a session to the user.

Applicant argues that that there is no support for the combination of Davis and TURGEON in regards to erasing the information for security reasons The examiner directs the applicant's attention to the following statement in TURGEON (para 004),

“First and foremost is the issue of security. Fraud in transactions may cost Web merchants many thousands of dollars in lost revenues. Furthermore, to do on-line purchases without any reservations, customers need to feel safe and assured that their confidential information will not be intercepted and misused by fraudulent users or by an unscrupulous merchant” Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the combination of Pitroda/Arnold/TURGEON/Official Notice and Inala does not teach wherein the portable device stores login information for a web site associated with the web passed transaction. The examiner disagrees and further directs the applicant's attention to Inala col 6, line 64 – col 7, line 10.

Applicant argues that the code for auto-login is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Davis' smart card is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of auto-login function software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.



Applicant argues that the combination of Davis and Inala does not teach the use of Bookmarks. The examiner disagrees and refers the applicant to the col 8, lines 25-41 of Inala, which was referenced in the last office action.

Applicant argues that the code for establishing bookmarks is not on the portable device. The examiner agrees that the code is apparently not from the portable device, however, Davis is capable of storing different software programs and could therefore also include the software for loading the form that is resident in the PC of Inala. Further, Inala discloses the use of a book mark function software except for the software being on the smart card. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place this software on the smart card, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey A. Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including  
After Final communications labeled  
"Box AF"]

For general questions the receptionist can be reached at  
**571.272.3600**

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Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner